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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,533	08/27/2001	Gerd M. Muller	740105-78	2799

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NIXON PEABODY LLP
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EXAMINER

FOREMAN, JONATHAN M

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 12/02/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,533

Applicant(s)

MULLER ET AL.

Examiner

Jonathan ML Foreman

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8,9,12-18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,10,11 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 7 and 19 - 22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,325,755 to Bushek et al.

In reference to claims 1 – 7 and 19 - 22, Bushek et al. discloses a partially implantable hearing system (Figures 3 – 5) comprising an electromechanical output transducer (162) selected from the group consisting of electromagnetic, electrodynamic, magnetostrictive, dielectric and piezoelectric transducers (Col. 8, lines 40 – 43); a micromanipulator (10) adapted to be attached to a cranial vault for positioning the transducer and for fixing the transducer in a set position (Col. 10, line 54 – Col. 11, line 27); a releasable coupling unit disposed between the transducer and the micromanipulator (Col. 11, lines 36 – 65; Col. 12, lines 22 - 25). The releasable coupling comprises a transducer-side coupling element (168, 165) and a micromanipulator-side coupling element (135, 139) being adapted to selectively engage each other and disengage from each other. The micromanipulator-side coupling element receives the transducer-side coupling element (Col. 11, lines 38 – 41). At least one of the coupling elements is partially made of an elastic, soft polymeric material (Col. 13, lines 13 – 29). The transducer-side coupling element is rotationally symmetrical.

Art Unit: 3736

In a released state, the transducer can be removed from the micromanipulator while maintaining the set position.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,325,755 to Bushek et al. in view of U.S. Patent No. 5,935,170 to Hakansson et al.

In reference to claims 10 and 11, Bushek et al. discloses a releasable coupling unit, but fails to disclose the releasable coupling being a snap-in coupling. Hakansson et al. discloses a partially implanted hearing aid (Col. 1, lines 6 – 13) wherein the releasable coupling affixed to the cranial vault is a snap-in coupling having a rigid annular receiving member, and the coupling element associated with the hearing aid is made partially elastic and adapted to snap into the rigid annular receiver member in a substantially axial direction (Figure 2; Col. 3, lines 18 – 22). It would have been obvious to replace the releasable coupling unit as disclosed by Bushek et al. to comprise a rigid annular receiving member, and a partially elastic member adapted to snap into the rigid annular receiver member in a substantially axial direction as taught by Hakansson et al. in order to provide a releasable coupling unit that prevents the need for large connection and disconnection forces (Col. 1, lines 30 – 50).

Art Unit: 3736

Response to Arguments

5. Applicant's arguments filed 9/8/03 have been fully considered but they are not persuasive. Applicant has asserted that Bushek et al. fails to disclose all of the cited claim limitations. Applicant has asserted that the support assembly (10) would correspond to the claimed "fixing means" not the "micromanipulator" and therefore Bushek et al. fails to disclose "a releasable coupling unit disposed between the transducer and the micromanipulator". However, the examiner disagrees. The claimed "fixing means" equates to the means for connecting the micromanipulator (10) as disclosed by Bushek et al. to the cranial vault, i.e. bone screws, staples, adhesives, etc. (Col. 11, lines 18 – 27). The support assembly (10) as disclosed by Bushek et al. is considered by the examiner to be the micromanipulator in that the positioning of the transducer is ultimately controlled by the original mounting of the support assembly (10). The "releasable coupling unit disposed between the transducer and the micromanipulator" is considered by the examiner to be composed of elements (168, 165) and (135, 139).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3736


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703)-305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F Hindenburg can be reached on (703)308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9306 for regular communications and (703)-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0858.

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JMLF
December 1, 2003


MAX F. HINDENBURG
SUPERVISORY PATENT EXAMINER
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